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Attorney Docket No.: 1301-1178
Halliburton Docket No.: 2003-IP-009460 U1 USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application:	Travis T. Hailey, Jr.
Serial No.	10/644,723
Filed:	August 20, 2003
Art Unit:	3672
Examiner:	William P. Neuder
For:	Isolation Packer Inflated by a Fluid Filtered From a Gravel Laden Slurry

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request For Review

Dear Sir:

This Request is being submitted concurrently with a Notice of Appeal.

Status

Claims 1-49 and 53-55 are pending, of which claims 1, 10, 17, 29, 34, 44 and 49 are in independent form. Claims 50-52 have been canceled. (See response dated May 31, 2006).

Rejections under 35 U.S.C. 102(e)

In the Office Action dated July 6, 2006, the Examiner rejected claims 1-42, 44-49 and 53-55 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,575,251 to Watson et al. ("Watson"). The Examiner has rejected claim 43 under 35 U.S.C. 103 as being obvious over Watson in

combination with U.S. patent No. 4,627,488 to Szarka ("Szarka"). (See Office Action dated July 6, 2006).

Independent claims 1, 10, 17, 29, 34, 44 and 49 are Patentable Over Watson

Independent claims 1, 10, 17, 29, 34, 44 and 49 have been rejected as being obvious over Watson, but this reference does not teach or suggest all the claim limitations recited in these independent claims as required to establish anticipation. (See 35 U.S.C. 102)

Watson fails to teach a "particulate filter" or "filtering a gravel laden slurry"

The rejected claims recite, in each case, either a "particulate filter" or the use of a particulate filter to remove gravel from a gravel laden slurry. (See Response dated May 31, 2006). In contrast, Watson is directed to a "gravel inflatable element" that is adapted for inflation by unfiltered, "gravel laden slurry." Specifically, Watson discloses a method of sealing an annulus in a well comprising expansion of a "gravel inflatable element" with a "gravel laden slurry." The "gravel inflatable element" comprises a passageway communicating between an exterior and an interior of the gravel inflatable element. The Examiner asserts that Watson discloses:

> Providing an inflatable packer having an interior volume; and
>
> Inflating the inflatable packer with gravel laden slurry. (See Office Action dated July 6, 2006).

Applicant does not dispute, and has never disputed, that Watson discloses both of the above limitations. Watson does not, however, disclose filling the inflatable element with an inflating fluid obtained by filtering the gravel out of a gravel laden slurry, as recited in each of the rejected claims. To the contrary, Watson specifically teaches that the fluid filling the inflatable element is the

unfiltered gravel laden slurry. The panel's attention is directed, for example, to the following specific and unequivocal teachings of Watson:

> "GRAVEL INFLATED ISOLATION PACKER" (Watson, Title)
>
> "The inflatable element is adapted for inflation by gravel." (Watson, Abstract)
>
> "The inflatable element is adapted for inflation by gravel, preferably by a gravel laden slurry." (Watson, Paragraph [0010])

In the prior Office Action, the previous Examiner had conceded that Watson fails to disclose either filling the packer with filtered inflating fluid or a particulate filter located in the passageway for filtering the gravel out of the gravel slurry. (See Office Action mailed March 2, 2006).

A "Check Valve" is Not a "Particulate Filter"

Examiner Neuder has retracted the prior Examiner's position on the teachings of Watson and asserts in the most recent Office Action that Watson does disclose a "particulate filter" and the step of "filtering." The Examiner now asserts that the "check valve" mentioned in Watson is a "particulate filter." (See Office Action dated July 6, 2006). The Examiner asserts that, although a "check valve" may not be explicitly referred to as a "particulate filter," a check valve will inherently incorporate an orifice or restriction. (See Office Action dated July 6, 2006). The Examiner further asserts that the orifice or restriction inherent to a check valve will inherently act to "filter" any particulates larger than the orifice or restriction size. (See Office Action dated July 6, 2006). According to the Examiner's logic, the "check valve" of Watson will inherently "filter" fluid passing through it, and is therefore a "particulate filter."

Applicant did not specifically define the term "filter" in the written description of the present application, or present any indication that it was being used in any manner other than the ordinary

and accustomed meaning it would have to one of skill in the art. Accordingly, this term is interpreted according to this ordinary meaning. Standard definitions of "filter" include:

> "A device that removes something from whatever passes through it."
>
> "A porous material through which a liquid or gas is passed in order to separate the fluid from suspended particulate matter."
>
> "A device containing a porous material, especially one used to extract impurities from air or water."

Any number of definitions are available, but any definition of a "particulate filter" must, by necessity, incorporate the concept of substantially removing particulate matter from a fluid passing through it. The Examiner has not shown that the "check valve" referenced in Watson meets any such definition. The Examiner's assertion that a "check valve" inherently "filters" fluid is factually unsupportable, given the fact that there are many check valve designs which do not include flow restrictions and do not block the flow of particulate matter.

The Teachings of Watson Preclude the use of a "Check Valve" Capable of "Filtering"

As noted above, there are a number of check valve designs which do not incorporate restrictions. It is not only possible that Watson incorporates such a filter, it is necessary. In other words, the operation of the Watson device requires the use of a non-restrictive check valve. The "check valve" of Watson must be, according to the explicit disclosure of Watson, of a type designed to pass particulate matter (gravel) through it and into the gravel inflatable element without separation. (See Watson, Paragraph [0010]). The "check valve" referenced in Watson could not, then, meet any normal definition of the word "filter," owing to the fact that the "check valve" of Watson must pass the particulate matter through it and into the gravel inflatable packer. Accordingly, contrary to the Examiner's assertion, Watson does not disclose any structure or

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function which could reasonably be read on a "particulate filter," and the Examiner's position on anticipation cannot be supported. Each of the other claims rejected by the Examiner is dependent from an allowable independent claim and is allowable for the same reasons as the claim from which it depends.

Conclusion

Applicant respectfully submits that Watson does not teach, or even suggest, an inflatable element filled with an inflating fluid obtained by filtering the particulates from a gravel laden slurry using a particulate filter, as recited in the pending claims. In view of the foregoing, the panel is respectfully requested to allow claims 1-49 and 53-55 presented for consideration herein.

Dated this 6th day of October, 2006.

Respectfully submitted:

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